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10/748,561	12/30/2003	Thomas R. Baranowski	0120-0249.15	8082

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John L. Alex  
Cook, Alex, McFarron, Manzo,  
Cummings & Mehler, Ltd.  
200 West Adams, Suite 2850  
Chicago, IL 60606

EXAMINER

MIGGINS, MICHAEL C

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/748,561

Applicant(s)

BARANOWSKI ET AL.

Examiner

Michael C. Miggins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 8-24<sup>33</sup> is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-24<sup>33</sup> is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/23/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **REJECTIONS WITHDRAWN**

1. The double patenting rejections set forth in the non-final rejection of 8/23/05, pages 5-6, paragraphs 4-5 have been withdrawn.

### **REJECTIONS REPEATED**

2. All of the 35 USC 103(a) rejections set forth in the non-final rejection of 8/23/05, pages 2-5, paragraphs 2-4.

Applicant has added that the liner be adhered directly to the inner surface and that the liner comprises 40 to 70 parts thermoplastic elastomer, 15 to 30 parts polyisobutylene and 10 to 35 part polybutylene to claim 8. Koyama discloses that he liner be adhered directly to the inner surface (abstract) and wherein said liner comprises a blend comprising polybutylene (column 8, lines 28-51 and column 13, lines 8-36). Doi discloses a liner comprising a blend of a thermoplastic elastomer and polyisobutylene (column 2, line 54 through column 3, line 24), wherein said thermoplastic elastomer comprises a polyolefin, a butyl-based rubber and a lubricant (column 2, line 54 through column 3, line 24).

With regard to the newly recited concentrations in claim 8, optimization of result effective variables such as concentration, absent a showing of clear and convincing evidence of an unexpected results, is obvious and within the level of one of ordinary skill in the art through routine experimentation (MPEP 2144). Therefore it would have been obvious to one of ordinary skill in the art to have provided applicant's recited

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concentration in order to provide improved gas barrier properties, improved sealing and improved peelability (applies to instant claim 8).

## **NEW REJECTIONS**

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koyama et al. (US 5,381,914) in view of Doi et al. (US 4253580).

The liner of Koyama does not contain an oil (applies to instant claim 33).

## **ANSWERS TO APPLICANT'S ARGUMENTS**

5. Applicant's arguments filed 11/23/05 have been carefully considered but are deemed unpersuasive. Applicant's arguments with regard to the double patenting rejection is moot since the rejection has been withdrawn.

Applicant has argued that one of ordinary skill in the art would not have been led to the liner of Doi because Doi discloses a metal crown and not a plastic one as taught by Koyama or currently claimed. However, Koyama discloses the plastic crown, furthermore Koyama is concerned with the sealability of the liner (column 1, lines 55-60) and Doi is also concerned with sealability (column 2, lines 55-60) and therefore the

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references are concerned with at least some of the same problems. Furthermore, the references are analogous because both are drawn to cap liners for containers such as bottles and jars. Applicant has argued that Doi has an adhesive. However, applicant's claims do not exclude the inclusion of an adhesive, especially since the applicant uses the term "comprising". Furthermore, Koyama does not use an adhesive and applicant has not claimed any liner adhesive properties or torque removal properties.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument against the combination of Koyama and Doi, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Koyama discloses a liner which does not contain an oil.

### **Conclusion**

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Miggins whose telephone number is 571-272-1494. The examiner can normally be reached on 1:00-10:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael C. Miggins  
Primary Examiner  
Art Unit 1772

A handwritten signature in black ink, appearing to read 'Michael C. Miggins', followed by a horizontal line and a small flourish.

MCM  
February 6, 2006